

Serial No. 09/834,208

### ***Remarks***

Reconsideration of this Application is respectfully requested.

Claims 5-10 and 12-18 are under consideration, with claims 5, 8 and 14 being independent claims. Claims 1-4 were originally filed. Claims 5-10 were added in the amendment filed February 8, 2004, claims 11-13 were added in the amendment filed July 19, 2004 and claims 14-18 were added in the amendment filed June 29, 2005. Claim 4 was cancelled in the amendment filed February 8, 2004 and claims 1-3 and 11 were cancelled in the amendment filed June 29, 2005.

This Reply is being submitted with a Notice of Appeal and a Pre-Appeal Request for Review.

The Examiner on pages 2-5 (paragraphs 1-7) has held the arguments made by the Applicant in the Reply mailed June 29, 2005 as not persuasive. The Applicant's position regarding the Examiner's position remains that the Examiner is using impermissible hindsight reconstruction of the Applicant's disclosure to arrive at the claimed invention. The Examiner has failed in Paragraphs 1-7 to provide a single motivation to combine the references except for unsupported statements that "it is well known in the art" to cure the deficiencies of the primary references. It is also noted by the Applicant that U.S. Patent Nos. 2,798,483; 4,802,473; 5,813,398; 5,819,731; 6,079,980 and 6,394,090 have never been cited by the Examiner in a PTO Form 892, nor provided to the Applicant. Since the Examiner simply listed these and other patents, without specifically addressing each, the patents cannot be addressed by the Applicant. Also, the source of the diagrams listed on pages 2, 3 and 4 was not provided by the Examiner. The ear loops labeled by the Examiner have been without a proper motivation to combine with

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the primary reference, and thus the applicants maintain that the Examiner has failed to establish a proper *prima facie* case of obviousness.

Based on the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejection of Claims under 35 U.S.C. 103(a)***

The Examiner rejected has maintained the rejection of claims 5-10, 12, and 13 and added a rejection of new claim 14 under 35 U.S.C. §103(a) as being unpatentable over Hudson (U.S. 2,843,121). The Examiner also stated that Hudson fails to teach a pair of bands extendible to loop over and around each ear of the patient. The Examiner additionally stated that "it is well-known in the art of masks to secure a mask using loops around a user's ears as an alternative to having a strap/band around the user's head as evidenced in U.S. patents 2494406, 2798483, 4802473, 4941470, 5701892, 5813398, 5819731, 6079980, 6095143 and 6394090." The '731 patent by Dyrud et al. has been previously addressed by Applicants, and does not cure the deficiency of Hudson due to the requirement in Dyrud et al. to have a strap that goes around the back of the neck, as shown on the face of the patent. This requirement teaches away from the Applicant's invention. The '892 patent teaches a dust mask with ear loops, but does not teach an adjustable strap, as required by the present invention, and thus teaches away from the Applicant's invention. It is also noted by the Applicant that U.S. Patent Nos. 2,798,483; 4,802,473; 5,813,398; 5,819,731; 6,079,980 and 6,394,090 have never been cited by the Examiner in a PTO Form 892, nor provided to the Applicant. Since the Examiner simply listed these and other patents, without specifically addressing each, the patents cannot be addressed by the Applicant.

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The Examiner failed to address the additional limitations of claim 5, 7, 8 and 10: 1) a pair of elastic bands, 2) both ends of each pair affixed at points of attachment to each of both sides of said oxygen mask, said bands extendible to loop over and around each ear of the patient and 3) adjustably securable to said patient by pulling the ends anteriorally through said points of attachment.

Regarding claims 6 and 9 (page 6, paragraph 11 of the action), the Examiner only addressed the limitation of four separate points of attachment, citing *St. Regis v. Bemis Co.*, 193 USPQ 8, and using as evidence U.S. Patent Nos. 2,494,406, 2,798,483, 4,941,470, 5,701,892, 5,813,398 and 6,394,090, without specifically pointing out the relevant sections. Again, the Examiner failed to address all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*.

In regard to claims 2, 6, and 9, the Applicant notes that claim 2 was cancelled in the amendment filed June 29, 2005. The Applicant repeats the argument set forth in the previous response regarding the Examiner's assertion that it would have been obvious to one of ordinary skill in the art to have four sets of attachment (citing *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8, (549 F.2d 833, (7th Cir. 1977)) and citing, again without comment, U.S. Patent Nos. 2,494,406, 2,798,483, 4,802,473, 4,942,470, 5,701,892, 5,813,398 and 6,394,090 to support his assertions). As the '406, '483, '473, '470, '892, '398 and '090 patents have again been cited by the Examiner without comment, the Applicant cannot address the concerns of the Examiner when such concerns have not been articulated. The Applicant asserts that the combination of the '271 and '027 patents do not cure the deficiencies of Hudson. The Applicant also asserts that *St. Regis Paper Co. v. Bemis* does not support the statement of the Examiner that the Applicant's invention is merely "duplicating essential working parts of a device." Regarding *St. Regis Co. v.*

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*Bemis Co.*, the court held that if the combination of prior elements is “synergistic, that is, ‘resulting in an effect greater than the sum of the several effects taken separately,’” it can be patented. The arrangements of the straps attached to the claimed oxygen mask is synergistic: the care provider is able to simultaneously provide oxygen therapy to a patient in need thereof AND position the mask over the patient with one hand, a function not possible with any of the combinations provided by the Examiner.

The Examiner also stated that the flap valve that was recited in claim 11-13 would have been obvious over Hudson and cited, without comment, U.S. Patent Nos. 4,098,271 and 4,865,027 as evidence to support his assertions. The Applicant continues to assert that the combination of the ‘271 and ‘027 patents does not cure the deficiencies of Hudson, and repeat their arguments set forth in the previous response. Again, the Examiner failed to address all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*.

Regarding claim 14 (page 6, paragraph 13 of the action), claim 15 (page 7, paragraph 14), claim 17 (page 7, paragraph 15), and claim 18 (page 8, paragraph 16)<sup>1</sup> the Examiner asserted that Hudson taught the structural limitations recited in claim 14 (a face mask molded from plastic to form a soft, one-piece covering for the mouth and nose of the patient, ... form a breathing chamber about the mouth and nostrils of the patient when the oxygen mask is positioned on the patient’s face,) and using as evidence the same patents he used as evidence on page 5, paragraph 10, without specifically pointing out the relevant sections. The Examiner repeated his arguments regarding the limitation of the ear loops and four separate points of attachment as discussed regarding claims 5, 7, 8 and 10 and claims 6 and 9, *supra*. Again, the Examiner failed to address

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<sup>1</sup> The Applicants assume that the Examiner intended to include the rejection he set forth over independent base claim 14 into the rejection of claims 15, 17, and 18.

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all the limitations of the claims or provide motivating statements from the art, as discussed regarding claims 5, 7, 8 and 10, *supra*. The arguments regarding *St. Regis Co. v. Bemis Co.* have been discussed, *supra*.

The Examiner has further rejected claim 16 over Hudson in view of Dyrud (the '731 patent; page 8, paragraphs 17 and 18). The Applicant's arguments regarding Hudson have been discussed, *supra*. The Applicant's arguments regarding Dyrud *et al.* in the paper filed December 8, 2004 (see page 4, and pages 5-6 of the Applicant's reply filed July 19, 2004) were rendered moot by the Examiner in the paper mailed February 18, 2005. Additionally, the Examiner has failed to cure the deficiency of Hudson, as the ear loops of Dyrud *et al.* extend around the back of the head, and thus do not teach the limitation of claim 16 that requires "a pair of elastic bands, both ends of each pair *affixed to each of both sides* of said mask, ...". The ear loops of Dyrud *et al.* are not both affixed to each of both sides of the mask. The arguments regarding *St. Regis Co. v. Bemis Co.* have been discussed, *supra*.

Therefore, the Applicant asserts that in all outstanding obviousness rejections, that the Examiner has failed to set forth a proper *prima facie* case of obviousness based upon the failure to address all the limitations of the claims and the Applicants assert that the Examiner has used forbidden hindsight reconstruction to craft the rejections. The Examiner has *never* provided a motivation to combine the references without using the Applicant's own disclosure as a guide and apparently his own opinion of what is known in the art; arguments maintained and repeated by the Applicant throughout the prosecution history of the case.

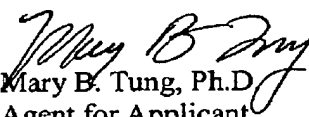
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***Conclusion***

Claims 5-10 and 12-18 are under consideration by the Examiner. In view of the above remarks, Applicant respectfully submits that the application and claims are in condition for allowance, and request that the Examiner reconsider and withdraw the objections and rejections. Applicant believes that a full and complete reply has been made to the outstanding Office action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

  
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